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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,030	01/04/2001	Ralf Ruther	P00.1923	3351

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EXAMINER

SINGH, RAMNANDAN P

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,030

Applicant(s)

RUTHER, RALF

Examiner

Ramnandan Singh

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed Nov. 15, 2005 have been fully considered but they are moot in view of the new ground(s) of rejection.

2. Status of Claims

Claims 1-4 are cancelled.

New claims 5-8 are added.

Claims 5-8 are pending.

3. Change of Scope

With the addition of new claims, a new search for prior art has been necessitated. As a result, new grounds of rejection are made.

Claim Objections

4. Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation "the telecommunication terminal **may** at least one of **call**" in lines 3-4. This is in error. Replace the term " **may** at least one of **call**" with the term "**may be** at least one of **called**". Appropriate correction is required.

Double Patenting

5. ANALYSIS:

To demonstrate that the co-pending application S/N: 09/743,255 and the instant application S/N: 09/743,030 are claiming common subject matter, a brief analysis is presented below:

(i) Claim 5 of Instant Application: A telecommunication terminal comprising:
a microprocessor having a menu structure with options;
an input device via which a user of the telecommunication terminal may be at least one of the called and modify the options;
at least one of an optical display and an acoustic display; and
a memory table in the microprocessor, the memory table including catch-words with each catch-word an option allocated thereto, wherein the catch-word may be selected by the user via the input device, with a respective option being immediately at least one of called and modified after the respective catch-word has been selected.

(ii) Claim 1 (Amended) of Co-pending Application S/N: 09/743,255:

A telecommunication terminal device, comprising:

at least one microprocessor;
an input with lightable keys;
at least one of an optical and acoustic display;

the microprocessor having a menu structure with options that are called by or modified by the user via the input; and

memory list with keys, each key word being assigned to an option, the key words of the memory list being selectable via the input and , after selection of the key word and conformation of the key word, individual steps leading to a corresponding option within the menu structure being displayed by lighting up a corresponding key of the input that is to be pressed next until said key has been pressed.

(iii) For comparing the above two claims, it may be noted that the "memory table" of claim 5 of the instant application corresponds to the "memory list" of claim 1 of the co-pending application. Second, the "catch-words" of the above claim 5 corresponds to the "key words" of the above claim 1. In view of the synonymous words used in the above claims, it is concluded that that claim 5 of the instant application S/N: 09/743,030 discloses all the features of claim 1 of the co-pending application except "lightable keys". Thus claim 5 of the instant application is a broad version of claim 1 of the copending application.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 5-8 of the instant application are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. S/N: 09/743,255 in view of the above analysis. Although the conflicting claims of the co-pending application are not identical, they are not patentably distinct from each other because claim 5 of the instant application is a broad version of claim 1 of the co-pending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation " the telecommunication

terminal **may be** at least one of called” in line 3. The word “**may be**” is indefinite. A similar thing holds for the limitation “the catch-words **may be**” in line 7.

A similar thing also hold for claims 6 and 7.

Claim Rejections - 35 USC § 103

10.. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgenthaler [US 6,310,609 B1] in view of Nazanin et al [US 5,625,683].

Regarding claim 5, Morgenthaler teaches a telecommunication terminal (i.e. a mobile phone), comprising:

a microprocessor having a menu structure with options (col. 2, lines 48-67);

an input device (i.e. keypad) via which a user of the telecommunication terminal may be at least one of called and modify the options [col. 6, lines 33-67]; and

at least one of an optical display and acoustic display [Figs. 1-3; col. 1, lines 20-29; col. 1, line 48 to col. 2, line 29; col. 5, lines 11-52; Anstarct].

Morgenthaler does not teach expressly a memory table (i.e. list) with key words that are assigned to an option, wherein the key words are selectable via the keys.

Nazanin et al teach a mobile telephone that comprises a directory of numbers that a user may desire to call [Abstract ; col. 3, line s 50-67]. They further teach that the called party's name may be input by the user and associated with the telephone number. This is a memory table (or memory list) where the catch-words (i.e. keywords) are the people's names. In Morgenthaler's system, the user would select the keyword (called party's name) from the memory list and then the appropriate keys on the keypad would light up to direct the user to complete the call to the selected person (identified by the keyword).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement a phone directory in Morgenthaler's system for the purpose of allowing the user to more easily dial a frequently dialed person's number without having to constantly remember that person's number (only the keyword, aka name needs to be selected from the memory list).

Regarding claim 6, the menu structure of Morgenthaler's system (including the keywords taught by Nazanin et al) is selectable via the alphanumeric keys and scroll keys [Morgenthaler; Fig. 1].

Regarding claim 7, Nazanin et al teach editing the keywords by the user (via the input disclosed by Morgenthaler) [[col. 3, lines 50-67].

Regarding claim 8, Morgenthaler and Nazanin et al teach that their devices are mobile telephones . In addition, Morgenthaler discloses that his invention may be utilized in any wired or wireless communication that comprises a keypad to direct an internal command sequence [Morgenthaler; col. 9, lines 15-25]. However, they do specify that the sets may be a DECT or GSM handset.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the communication device would have been a DECT or GSM handset (or any other brand or standard of telecommunicationsn device) for the purpose of allowing the invention to be used by users of all telecommunications terminals.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Beatty [US 5,675,630] teaches a method of associating features, such as phone number directories [Whole document].

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Sinh can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2644



SINH TRAN
SUPERVISORY PATENT EXAMINER